

REMARKS

This is a full and timely response to the final Official Action mailed January 20, 2004 (Paper No. 15). Reconsideration of the application in light of the foregoing amendments and the following remarks is respectfully requested.

By the present amendment, claims 1, 4 and 18-26 have been cancelled. Thus, claims 3, 5-15 and 27-34 are currently pending.

Claims 8, 9 and 27-33 have been allowed. Applicant wishes to thank the Examiner for the allowance of these claims.

The final Office Action also contains a statement of reasons for the allowance of claims 8, 9 and 27-33. Applicant agrees with the Examiner's conclusions regarding patentability, without necessarily agreeing with or acquiescing in the Examiner's reasoning. In particular, Applicant believes that the application is allowable because the prior art fails to teach, anticipate or render obvious the invention as claimed, independent of how the invention is paraphrased.

With regard to the prior art, the Office Action rejected claims 1, 2, 4-7, 10-15, 18-21, 23-25 and 34 as unpatentable under 35 U.S.C. § 103(a) in view of the combined teachings of EP 0519667 A1 to Kikuchi ("Kikuchi") and U.S. Patent No. 5,138,457 to Sakai et al. Claims 3, 22 and 26 were rejected under 35 U.S.C. § 103(a) as unpatentable over the combined teachings of Kikuchi, Sakai and U.S. Pat. No. 5,220,602 to Robbins et al. ("Robbins"). With respect to the claims that remain pending, these rejections are respectfully traversed.

Claim 3 has been rewritten as an independent claim containing verbatim the recitations of cancelled claim 1. Claim 3 recites:

For use in a cable television converter terminal, a passthrough circuit for passing a tuned signal from a tuner to a radio frequency modulator for output to external equipment, the passthrough circuit arrangement comprising:

a first signal path, arranged to receive the tuned signal from the tuner and to provide a NICAM signal component of the tuned signal to the radio frequency modulator; and

a second signal path, arranged to receive the tuned signal from the tuner and to provide at least one other signal component of the tuned signal to the radio frequency modulator;

wherein the first signal path comprises a NICAM surface acoustic wave filter, coupled to receive the tuned signal from the tuner and configured and arranged to pass a NICAM signal component of the tuned signal and to substantially reject non-NICAM signal components of the tuned signal; and

wherein the NICAM surface acoustic wave filter outputs a signal to a mixer which is set at a selected frequency using a crystal oscillator.

(emphasis added)

The recent final Office Action concedes that the combination of Kikuchi and Sakai fails to teach or suggest the claimed mixer and oscillator receiving the output of a NICAM SAW filter. Consequently, the Office Action relies on Robbins. As cited by the Office Action, Robbins teaches an oscillator (38) and mixer (40).

However, Robbins teaches an oscillator (38) and mixer (40) that are located away from a NICAM filter (48). Robbins does not teach or suggest a mixer and oscillator receiving the output of a NICAM filter as recited in claim 3. In fact, no prior art reference of record teaches or suggest this subject matter.

"To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Consequently, the rejection of claim 3 should be reconsidered and withdrawn.

Claim 5 has been rewritten as an independent claim containing verbatim the recitations of cancelled claim 1. Claim 5 recites:

For use in a cable television converter terminal, a passthrough circuit for passing a tuned signal from a tuner to a radio frequency modulator for output to external equipment, the passthrough circuit arrangement comprising:

a first signal path, arranged to receive the tuned signal from the tuner and to provide a NICAM signal component of the tuned signal to the radio frequency modulator; and

a second signal path, arranged to receive the tuned signal from the tuner and to provide at least one other signal component of the tuned signal to the radio frequency modulator;

wherein the first signal path comprises a NICAM surface acoustic wave filter, coupled to receive the tuned signal from the tuner and configured and arranged to pass a NICAM signal component of the tuned signal and to substantially reject non-NICAM signal components of the tuned signal; and

wherein the first signal path further comprises a mixer, coupled to receive the NICAM signal component passed by the NICAM surface acoustic wave filter, and configured to downconvert the NICAM signal component to a baseband frequency.

Claim 11 similarly recites:

For use in a cable television converter terminal, a passthrough circuit for passing a tuned signal from a tuner to a radio frequency modulator for output to external equipment, the passthrough circuit arrangement comprising:

a NICAM surface acoustic wave filter, coupled to receive the tuned signal from the tuner and configured and arranged to pass a NICAM signal component of the tuned signal and to substantially reject non-NICAM signal components of the tuned signal;

a mixer, coupled to receive the NICAM signal component passed by the NICAM surface acoustic wave filter, and configured to downconvert the NICAM signal component to a baseband NICAM IF frequency; and

a low pass filter, coupled to receive the downconverted NICAM signal component from the mixer and configured and arranged to attenuate mixer harmonics from the downconverted NICAM signal and to provide a NICAM output signal to the radio frequency modulator.

According to the final Office Action, Kikuchi teaches the claimed mixer that receives a NICAM signal from the NICAM SAW filter and downconverts the signal to baseband. The final Office Action points to the adder (23) taught by Kikuchi as the claimed mixer. However, the adder (23) clearly does not "downconvert the NICAM signal component to a baseband frequency" as claimed.

Consequently, the final Office Action argues that block 32 of Kikuchi downconverts the NICAM signal to baseband. (Paper No. 15, p. 5). This is clearly incorrect. As shown in Fig. 3 of Kikuchi, an intermediate frequency (IF) signal (SIF) is input to block 32, and the output of block 32 remains an intermediate frequency signal (SIF (F_N)). Block 32 does not convert the signal, it merely filters out the NICAM component of the signal. Kikuchi does not teach or suggest that block 32 downconverts the signal. Thus, the cited combination of prior art references fails to teach or suggest the claimed mixer that downconverts the NICAM signal from a NICAM SAW filter to baseband.

Again, "[t]o establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974)." M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Consequently, the rejection of claims 5-7 and 11-15 should be reconsidered and withdrawn.

Claim 10 recites:

For use in a cable television converter terminal, a passthrough circuit for passing a tuned signal from a tuner to a radio frequency modulator for output to external equipment, the passthrough circuit arrangement comprising:

a first signal path, arranged to receive the tuned signal from the tuner and to provide a NICAM signal component of the tuned signal to the radio frequency modulator; and

a second signal path, arranged to receive the tuned signal from the tuner and to provide at least one other signal component of the tuned signal to the radio frequency modulator;

wherein the first signal path is constructed as a unitary circuit module.

(emphasis added).

Claim 34 similarly recites:

A method of making a passthrough circuit for passing a tuned signal from a tuner to a radio frequency modulator for output to external equipment, the passthrough circuit arrangement comprising:

providing a first signal path, arranged to receive the tuned signal from the tuner and to provide a NICAM signal component of the tuned signal to the radio frequency modulator;

providing a second signal path, arranged to receive the tuned signal from the tuner and to provide at least one other signal component of the tuned signal to the radio frequency modulator; and

constructing the first signal path as a unitary circuit module.

(emphasis added).

In contrast, the cited combination of prior art, particularly Kikuchi, fails to teach or suggest that the first signal path is constructed as a unitary circuit module. According to the final Office Action, “Kikuchi further *inherently* suggests ‘wherein the first signal path is constructed as a unitary circuit module’ because the circuitry of the NICAM processing is bounded in a block 32.” (Paper No. 15, p. 6) (emphasis added).

“Inherency, however, may not be established by probabilities or possibilities.” *In re Robertson*, 49 USPQ2d 1949, 1950 (Fed. Cir. 1999) (citations omitted). “[T]he examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic *necessarily* flows from the teachings of the applied prior art.” *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990) (emphasis in original); see also, MPEP § 2112 (quoting Levy).

The final Office Action has failed to indicate how the Kikuchi reference “necessarily” teaches a unitary circuit module as claimed. Moreover, it cannot reasonably be argued that Kikuchi “necessarily” teaches the claimed unitary circuit module. Consequently, the inherency argument made by the final Office Action is legally insufficient to support the rejection of claims 10 and 34.

In actuality, the box (32) in Fig. 3 of Kikuchi is used merely for the purpose of discussing the elements of the digital audio path as a group and does not indicate structure. There is no teaching or suggestion in Kikuchi that the elements of the digital audio path are physically formed as a unitary circuit module.

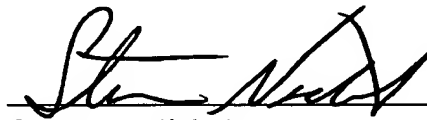
According to the Office Action, “block [32 of Kikuchi] can be placed within a module as a convenience [sic] manner to place and replace that module.” (Paper No. 15, p. 5). Applicant agrees, but that teaching comes exclusively from Applicant’s specification and *not from the prior art*. Applicant’s specification states that in “a particular embodiment of the present invention, the NICAM SAW filter 226, mixer 228, and low pass filter 230 may be constructed as a unitary circuit module. This circuit module can be removed from the converter terminal and replaced easily and at relatively little cost.” (Spec., p. 15).

Thus, the cited prior art clearly fails to teach or suggest that the elements of the first signal path are constructed as a unitary circuit module as claimed. “To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art. *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974).” M.P.E.P. § 2143.03. Accord. M.P.E.P. § 706.02(j). Consequently, the rejection of claims 10 and 34 should be reconsidered and withdrawn.

Entry and consideration of this amendment are proper under 37 C.F.R. § 1.116 for at least the following reasons. The present amendment makes only those changes necessary to place the application in better form for appeal. The amendment does not raise new issues requiring further search or consideration. Therefore, entry of the present amendment is proper under 37 C.F.R. § 116 and is hereby requested.

For the foregoing reasons, the present application is thought to be clearly in condition for allowance. Accordingly, favorable reconsideration of the application in light of these remarks is courteously solicited. If any fees are owed in connection with this paper which have not been elsewhere authorized, authorization is hereby given to charge those fees to Deposit Account 18-0013 in the name of Rader, Fishman & Grauer PLLC. If the Examiner has any comments or suggestions which could place this application in even better form, the Examiner is requested to telephone the undersigned attorney at the number listed below.

Respectfully submitted,



Steven L. Nichols
Registration No. 40,326

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Steven L. Nichols, Esq.
Managing Partner, Utah Office
Rader Fishman & Grauer PLLC
River Park Corporate Center One
10653 S. River Front Parkway, Suite 150
South Jordan, Utah 84095

(801) 572-8066
(801) 572-7666 (fax)